

Remarks

1. Introduction

Applicant submits that the Examiner has clearly erred in rejecting the claims. The Examiner has failed to point to any objective evidence that would logically lead to the invention recited in Applicant's claims. At a minimum, the Examiner has failed to cite any objective evidence that would suggest or logically lead to Applicant's claimed use of a mobile-IP home agent or to Applicant's claimed use of a count keyword threshold.

The Examiner stated in a closing section of the office action that the Examiner feels Applicant has claimed the invention too broadly, and the Examiner noted that Applicant has failed to significantly narrow the definition or scope of the claims. Yet at issue is not whether Applicant's invention is claimed broadly. Rather, at issue is whether the prior art of record would have rendered obvious the invention *as specifically claimed*. The Examiner bears the burden to establish *prima facie* obviousness by pointing out how the invention follows logically from the cited art and specifically by citing objective evidence that would have suggested or logically led to the claimed invention. In this case, notwithstanding at least six office actions, the Examiner has not made out such a *prima facie* case. Rather, while the Examiner has pointed out various discrete elements of Applicant's claims in one reference or another, the Examiner has not pointed to any objective evidence that would have suggested or logically led to Applicant's claimed invention as a whole. Consequently, the claim rejections are improper and should be withdrawn, and the claims should be allowed.

2. The Cited Art Does Not Disclose or Suggest the Claimed Use of a Mobile-IP Home Agent

In the office action mailed January 23, 2007, the Examiner largely repeated the rejections set forth in the previous office action, except that the Examiner substituted for the Liu reference a citation to the Background of Applicant's patent application, which the Examiner characterized as "Applicant's Admitted Prior Art" or "AAPA." However, all the Examiner asserted in that regard is that Applicant's Background section discloses routing web pages through a mobile-IP home agent. (The Examiner incorrectly characterized that disclosure as relating to a "provisioning system." But it appears that that mischaracterization is not relevant.) With that, the Examiner then summarily concluded that "[i]t would have been obvious to combine the teaching of Herz-Eichstaedt-Shimizu with AAPA in order to allow mobile users the ability to utilize the system of Herz, thereby allowing mobile users access to information of relevance and interest to the user without requiring the user to expend an excessive amount of time and energy as supported by Herz." (See Office Action at page 5, lines 1-8.)

Applicant submits that the Examiner has clearly erred in rejecting claims 6 and 12, because the Examiner has failed to point to any objective evidence that suggests or logically leads to the invention recited in those claims. It seems that the Examiner believes the basic idea of routing web pages through a mobile-IP home agent would lead to carrying out the mobile-IP home agent functions recited in claims 6 and 12. Yet the Examiner has pointed to no objective evidence that suggests having a mobile-IP home agent carry out such functions.

Furthermore, the Examiner has not even asserted that carrying out the mobile-IP home agent functions of claims 6 and 12 logically follows from the prior art. Rather, the Examiner has asserted at best that (i) AAPA teaches a system in which web pages are routed through a mobile-IP home agent and (ii) it would be obvious to combine the teachings of Herz, Eichstaedt, and

Shimizu with AAPA. Yet the Examiner has not asserted that such a combination would logically result in the invention recited in claims 6 and 12.

It is entirely plausible that if Herz-Eichstaedt-Shimizu were to be combined with the concept of routing web pages through a mobile-IP home agent, the result would be that web pages would be routed through a mobile-IP home agent *but that the functions of Herz-Eichstaedt-Shimizu would be performed elsewhere*. The Examiner has not pointed to any objective basis to conclude otherwise, or asserted that the result would be something other than this, or particularly that Applicant's invention would result from combining Herz-Eichstaedt-Shimizu with the concept of routing web pages through a mobile-IP home agent.

In fact, the only reason of record for concluding that Applicant's claim functions would be carried out at a mobile-IP home agent seems to be *Applicant's* claims themselves. Yet using hindsight reconstruction to conclude that a claimed invention is obvious without citing to objective evidence that leads to such a conclusion is impermissible. *See* M.P.E.P. § 2143 (stating that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art"); *In re Royka*, 490 F.2d 981 (CCPA 1974); see also *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (explaining that an Examiner can only meet the burden of establishing a *prima facie* case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references"); *In re Lee*, 277 F.3d 1338, 1342-43 (Fed. Cir. 2002) (stating that rejections under 103 must be based on evidence). In this case, any conclusion to carry out *the specifically claimed functions at a mobile-IP home agent* is gleaned entirely from Applicant's disclosure and not at all from any objective evidence cited by the Examiner.

Because the Examiner has not cited any objective evidence that suggests or logically leads to the invention recited in claims 6 and 12, and because the Examiner has not even asserted that the invention recited in claims 6 and 12 would logically result from combining Herz, Eichstaedt, and Shinnizu with the concept of routing web pages through a mobile-IP home agent, the Examiner has clearly failed to establish *prima facie* obviousness of claims 6 and 12. Therefore, Applicant submits that claims 6 and 12 are allowable. Furthermore, without conceding the Examiner's other assertions, Applicant submits that claims 15-20 are allowable for at least the reason that they depend from allowable claim 12.

3. The Cited Art Does Not Disclose or Suggest the Claimed Use of a Mobile-IP Home Agent

Furthermore, as noted in Applicant's last response, claims 12 and 27 provide for establishing a count of web pages sent to a user that each contain *at least a threshold number of keywords related to the given subject*. Beneficially, the threshold number may allow for greater specificity in identifying interest in a given subject and also may reduce server load, for instance.

As Applicant further noted, the Examiner has asserted that Herz teaches this function of counting pages that each contain at least a threshold number of keywords related to the given subject, citing to Herz at column 13, lines 5-17, column 15, lines 25-34, and column 17, lines 10-24. Yet, as Applicant further noted, Applicant has reviewed these portions of Herz and submits that they do not teach this claim element, for at least the reasons set forth in Applicant's last responses.

In the office action mailed January 23, 2007, when responding to Applicant's arguments, the Examiner asserted that in order for profile generation services in Eichstaedt to take place, "the page must contain at least one keyword for that particular interest (i.e., the profile would not consider "boating" as an interest if none of the pages contain anything about boats)." (See

1/23/07 office action, at section 6.) However, the Examiner did not point to any specific teachings or suggestions of this concept in the extensive Herz or Eichstaedt references. For instance, the Examiner did not point to any objective disclosure of counting a number of web pages sent to a user that each contains at least a threshold (non-zero) number of keywords related to the given subject.

Applicant then asserted that, because the Examiner did not cite objective evidence that suggests modifying the cited art to include Applicant's claim element of "establishing a count of web pages sent to a user that each contains at least a threshold number of keywords related to the given subject, wherein the threshold is non-zero", the Examiner failed to establish *prima facie* obviousness of claims 12 and 27. Therefore, Applicant asserted that claims 12 and 27, and their dependent claims, are allowable.

In the latest office action, the Examiner did not substantively address or rebut Applicant's position. Rather, the Examiner merely reiterated the Examiner's citations to Herz as set forth in the 1/23 office action. The Examiner has still not pointed to any specific teachings or suggestions of this concept in the extensive Herz or Eichstaedt references. For instance, the Examiner has still not pointed to any objective disclosure of counting a number of web pages sent to a user that each contains at least a threshold (non-zero) number of keywords related to the given subject.

The Examiner construed Applicant's previous response (incorrectly characterized as "Applicant's arguments filed December 18, 2006") to be "moot" in view of the Examiner's new reliance on "AAPA." However, that new reliance on "AAPA" does not relate to this point. Notwithstanding the Examiner's reliance on "AAPA," the Examiner has still failed to cite any

objective disclosure of counting a number of web pages sent to a user that each contains at least a threshold (non-zero) number of keywords related to the given subject.

Because the Examiner has not cited any objective evidence that suggests or logically leads to modifying the cited art to include Applicant's claim element of "establishing a count of web pages sent to a user that each contains at least a threshold number of keywords related to the given subject, wherein the threshold is non-zero", the Examiner failed to establish *prima facie* obviousness of claims 12 and 27. Therefore, Applicant again submits that claims 12 and 27 are allowable. Further, without conceding the Examiner's other assertions, Applicant submits that claims 15-20 and 28-30 are allowable for at least the reason that they depend from allowable claim 12 or allowable claim 27.

4. Conclusion

In view of the foregoing, Applicant submits that all of the claims are allowable, and Applicant therefore respectfully requests favorable reconsideration and allowance of the claims.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is welcome to call the undersigned at (312) 913-2141.

5. Deposit Account Authorization

Applicant authorizes the office to charge any underpayment or credit any overpayment to Deposit Account No. 210765.

Respectfully submitted,

**McDONNELL BOEHNEN
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